

REMARKS

Applicant has considered and studied the Office Action dated March 14, 2005. Claims 1-20 are pending. Claims 19-20 are allowed. Claims 1-3, 8 and 12-14 have been rejected. Claims 4-7, 9-11, and 15-18 have been objected to. Claims 1, 2, 3, 4, 5, 9, and 12-15 have been amended. Claim 8 has been cancelled. No new matter has been added with these amendments to the claims. The rejections have been traversed below. Applicant respectfully requests reconsideration of the application in light of the following remarks.

§ 102(b) Rejection

Claims 1 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Eklof. The rejection of claims 1 and 12 is respectfully traversed. An analysis of the rejection of claim 1 is provided below. A similar analysis applies to the rejection of claim 12.

A proper rejection for anticipation under § 102 requires complete identity of invention. The claimed invention, including each element thereof as recited in the claims, must be disclosed or embodied, either expressly or inherently, in a single reference. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991); Standard Havens Prods., Inc. v. Gencor Indus., Inc., 953 F.2d 1360, 1369, 21 U.S.P.Q.2d 1321, 1328 (Fed. Cir. 1991).

Applicant respectfully submits that claims 1 and 12 have been amended, with support for amendment contained in the Specification on page 7, lines 1-15 and in Fig. 4.

Eklof discloses a digitally controlled ring signal generator. Eklof teaches or suggests a digital control circuit 101 being controlled by a microprocessor 500 (col. 3, lines 65-67). “[A] microprocessor . . . can turn the ring signal on and off and select different ring signal frequencies” (col. 4, lines 1-5). “Digital control circuit 101 . . . produces drive signals 514 and 515” (col. 4, lines 13-15). “Each of those drive signals drives a pair of optically controlled solid state switches (LEDs)” (col. 4, lines 15-17). “Each pair contains one normally closed (N.C.) switch and one normally opened (N.O.) switch” (col. 4, lines 17-24). “The connection of the switches creates a path for DC line current through the circuit when neither drive signal is active . . . the case when no ring signal is generated” (col. 4, lines 19-23).

In contrast to Eklof, amended claim 1 of the present invention recites “a relay control device . . . to generate a ring generation inhibit signal in response to the relay interrupt command to disable generation of a ring signal” In other words, the amended claim 1 recites a ring generation inhibit signal to turn-off the ring signal generator. However, as discussed above, Eklof teaches that when no ring signal is generated, no drive signal is active to operate the ring signal generator. In summary, it is respectfully submitted that, unlike amended claim 1, Eklof fails to teach or suggest, a ring generation inhibit signal to turn-off the ring signal generator.

In addition, amended claim 1 recites “the synchronous signal controls timing of the relay control signal to selectively transfer one of the ring signal or a call signal to the subscriber telephone.” Eklof teaches, however, that when no ring signal is generated, no drive signal is active would not teach or suggest, one synchronous signal controlling the timing of the relay to switch the subscriber telephone between a ring signal and a call signal, as claimed in amended claim 1.

Thus, it is respectfully submitted that amended claim 1 should pass to allowance for either of the reasons discussed above. Similarly, amended claim 12 is allowable for the same reasons as amended claim 1, because claim 12 recites substantially the same elements as claim 1.

§ 103(a) Rejection

Claims 2 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eklof in view of Applicant’s admitted prior art. The rejection is respectfully traversed with respect to claims 2 and 13. An analysis of the rejection of claim 2 is provided below. A similar analysis applies with respect to the rejection of claim 13.

A rejection under 35 U.S.C. 103 requires both (1) a suggestion of the prior art to make and use the claimed device and (2) that one skilled in the art would make a reasonable expectation of making and using the compositions or device, or in carrying out the claimed process.

It is well settled that a reference must provide some motivation or reason for one skilled in the art (working without the benefit of the applicant’s specification) to make the necessary changes in the disclosed device. The mere fact that a reference may be modified in the direction of the claimed invention does not make the modification obvious unless the reference expressly or impliedly teaches or suggests the desirability of the modification. In re Gordon, 221 USPQ

1125, 1127 (Fed. Cir. 1984); Ex parte Clapp, 227 USPQ 972, 973 (Bd. App. 1985); Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. App. 1984).

The Examiner bears the burden of establishing the existence of either 1) some objective teaching in the prior art or 2) knowledge generally available to one of ordinary skill in the art which would lead that individual to change the primary reference. In re Jones, 21 USPQ2d 1941, 1943-44 (Fed. Cir. 1992). Section 103 does not allow the Examiner to engage in a picking and choosing from the prior art only to the extent that it will support a holding of obviousness, while excluding parts of the prior art essential to the full appreciation of what the prior art suggests to one of ordinary skill in the art. In re Wesslau, 147 USPQ 391 (CCPA 1975). “Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.” ACS Hospital Systems v. Montefiore Hospital, 221 USPQ 929, 933 (Fed. Cir. 1984).

Applicant respectfully submits that claims 2 and 13 have been amended, with support for amendment contained in the Specification on page 7, lines 1-5 and in Fig. 4. There is no motivation or suggestion to modify Eklof, in the direction of amended claims 2 or 13, without the benefit of the Applicant’s disclosure. For example, it is respectfully submitted that Eklof teaches or suggests turning off or turning on the ring signal generator. Eklof, unlike claims 2 or 13, teach initial transfer of the ring signal from the ring generator to the subscriber telephone upon a low voltage period of the ring signal to prevent damage to and reduce switching noise generated by the relay. Thus, it is respectfully submitted that amended claims 2 and 13 should be allowable.

Claims 3, 8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eklof in view of Applicant’s admitted prior art. Claim 8 has been cancelled without prejudice. There is no motivation or suggestion to modify Eklof in the direction of amended claim 3 or 14 without the benefit of the Applicant’s disclosure. Furthermore, claims 3 and 14 are allowable by virtue of their dependence on claims 1 and 12, respectively. Consequently, it is respectfully submitted that claims 3 and 14 should be allowable for either of the reasons discussed above.

Objected to Subject Matter

Claims 4-7, 9-11, and 15-18 have been objected to as being dependent upon a rejected base claim, but deemed allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

It is respectfully submitted that claims 4-5 and 15 should pass to allowance because these claims have been amended to include all the elements of the base claims and any intervening claims. Claim 6 by virtue of its dependence on amended claim 4, and claim 7 by virtue of its dependence on amended claim 5 should be allowable. It is respectfully submitted that claims 9-11 are also allowable by virtue of their dependence on amended claim 1. It is further submitted that claims 16-18 are allowable by virtue of their dependence on amended claim 15.

Allowable Subject Matter.

Applicant thanks the Examiner for finding allowable subject matter in claims 19 and 20.

CONCLUSION

For the above reasons, Applicant respectfully requests that the Examiner reconsider and withdraw the rejections of the claims and issue a notice of allowance.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references


If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

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Respectfully submitted,

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